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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,451	04/20/2001	David Corts	4232-4002	4838
7590 06/29/2006 MORGAN & FINNEGAN, L.L.P. 345 Park Avenue New York, NY 10154-0053			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,451

Applicant(s)

CORTS ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-212 is/are pending in the application.
- 4a) Of the above claim(s) 32-67 and 130-222 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 68-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 17 March 2006 (and referred to in a filing on 7 April 2006) have been fully considered but they are not persuasive. The arguments are addressed at para. 7 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 6-17, 19, 24, 25, 27-31, 68, 69, 72, 76-87, 91, 92, 94-100, 104-115, 117, 122, 123, and 125-129 are rejected under 35 U.S.C. 102(b) as being anticipated by Foladare et al. (US005819160A).
5. Foladare et al. teaches (independent claims 1, 29-31, 68, 96-99 and 127-129) a method, apparatus, and computer readable medium encoded with said method, for coordinating supplemental data transmissions with broadcast data transmitted by a plurality of broadcasters, the method comprising: receiving access to a *subscription content database* (col. 2 line 44) of radio broadcast and supplementary information (col. 1 lines 7-8, 58-67 and col. 2 lines 55-60), which reads on receiving schedule information for each of a plurality of broadcasts, the schedule information including a schedule of broadcast data to be

transmitted by each broadcaster at predetermined times¹; identifying, from the received schedule information, broadcast data for transmission by *subscription control system 10*, which reads on a first broadcaster, at a predetermined time (col. 1 line 67 to col. 2 line 5 and col. 3 line 59 to col. 4 line 10); determining supplemental data (e.g., *news selections*, col. 2 lines 55-60) to be presented to listeners of the broadcast data on a digital data receiver (*digital radio 12*, col. 3 line 62), which also reads on transmitting at least a portion of the supplemental data (from *news service 24*, col. 4 lines 34-38 and Fig. 1) to the first broadcaster/*subscription control system 10*.

6. Foladare et al. does not explicitly teach (independent 68 and 96-98) that said schedule information transmitted to the *subscription control system 10* acting as a digital data provider includes a time when particular broadcast data is to be transmitted to a group of listeners. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the *subscription control system 10* can acquire said particular broadcast data only if it knows the time of said broadcast.
7. Applicant argues (pp. 20-21) that the reference does not teach “determining supplemental digital data” and “transmitting at least a portion of the digital data”. Those specific limitations are rejected in the last five lines of para. 5 above. To traverse this rejection, applicant cites a number of features of the instant invention disclosed in the specification, including:

“The scheduling information is set by the broadcaster not the user. (See specification, page 14, lines 7-17).”

“In contrast to the elements recited in independent claims 1, 29-31, 68, 96-99 and 127-129, Foladare does not disclose a method for making the determination of types of data to be transmitted based on previous selections by the listener, or independent of that which was previously selected, as stated in the specification, and scheduling the broadcast of such data. (See, specification, page 10, lines 20-25 through page 11, lines 1 - 15).”

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited

¹ Since broadcasting is not done at random, it is inherently done at predetermined times.

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in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. For independent claims 99 and 127-129, *main control unit 16* reads on a traffic management system.
9. Foladare et al. also teaches at the citations given above claims 2, 69, 72 and 110; claims 8, 78 and 106; claims 11, 81 and 109; claims 14, 15, 84, 85, 112 and 113; claims 17, 87 and 115; claims 19 and 117, where a change in schedule information is not materially different from new schedule information; claims 24, 91 and 122; and claims 25, 27, 28, 92, 94, 95, 123, 125 and 126.
10. Foladare et al. also teaches claims 6, 7, 76, 77, 104, and 105 (col. 2 lines 27-35); claims 9, 12, 13 (*Baseball*, the name of a game, reads on a statistic of sport) 16 (simultaneously with what?), 79, 82, 83, 86, 107, 110, 111 and 114 (col. 3 line 50); and claims 10, 80 and 108 (col. 2 lines 44-51).
11. Claims 3-5, 18, 20-23, 26, 70-75, 88-90, 93, 101-103, 116, 118-121 and 124 are rejected under 35 U.S.C. 103(a) as being obvious over Foladare et al. (US005819160A).
12. Foladare et al. does not teach (claims 3-5, 18, 73-75, 88, 101-103 and 116) analog radio. Because it would expand the service to customers with analog radios, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add analog radio to the teachings of Foladare et al.
13. Foladare et al. does not teach (claims 20, 21, 118 and 119) a second broadcaster. A second service (i.e., a second *subscription control system 10*) would read on a second broadcaster. Because competition is beneficial and common in broadcasting, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a second broadcaster/second *subscription control system 10* to the teachings of Foladare et al.
14. Foladare et al. does not teach (claims 22, 23, 70, 71, 89, 90, 120 and 121) selling advertising as supplemental digital data. Foladare et al. does teach *news selections* (col. 2 lines 55-60) as supplemental digital data. Since any promotion reads on advertising, said distribution of news selections inherently reads on advertising as supplemental digital data. Because selling is a common mechanism for funding services, it would have been obvious

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to one of ordinary skill in the art, at the time of the invention, to add selling to the teachings of Foladare et al.

15. Foladare et al. does not teach (claims 26, 93 and 104) displaying supplemental data continuously during a length of broadcast data. Because stock ticker crawls are popular additions to business news programming, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add, to the teachings of Foladare et al., stock ticker crawls as supplemental data displayed continuously during a length of business news broadcasts.

Conclusion

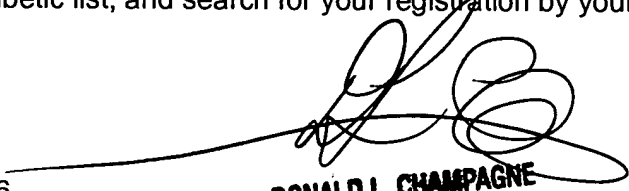
16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
19. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
22. Applicant may have after final arguments considered and amendments entered by filing an RCE.
23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

22 June 2006


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
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